

REMARKS

This communication responds to the Decision on Appeal dated June 18, 2010 in which the Board upheld the Examiner's rejection of all claims in the Final Office Action (*Office Action*) dated February 14, 2008. Applicants have amended claims 1, 5, 6, 9, 11-14, 16-21, 24, 25, 27, 29-31, 33, and 35-39. Additionally, Applicants have canceled claims 2-4, 7, 8, 10, 15, 22, 23, 26, 28, 32, 34, and 40. No claims are added. Consequently, claims 1, 5, 6, 9, 11-14, 16-21, 24, 25, 27, 29-31, 33, and 35-39 are now pending in this application.

Rejection of the Claims under 35 U.S.C. §102(b)

On page 2, paragraph 2 of the *Office Action*, the Examiner rejected claims 1-6, 31-36, and 40 under 35 U.S.C. § 102(b) for allegedly being anticipation by U.S. Patent No. 5,919,257 to *Trostle*. Applicants respectfully traverse these rejections.

In order to anticipate a claim, a reference must teach all limitations, arranged or combined in the same way as recited in Applicant's claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.¹

Since *Trostle* fails to disclose all limitations of at least independent claims 1, 31, and 33,² these claims are not anticipated, and are thus novel.

In particular, amended claim 1 recites, *inter alia*,

[G]enerating a first identifier associated with a first user identity, the first identifier to be stored in a shill cookie on a client machine of the first user, the first identifier being generated

¹ *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008); emphasis added.

² Independent claims 32 and 40 are now canceled.

responsive to at least one of a plurality of triggering events event with respect to the network-based transaction facility, the network-based transaction facility being coupled to the client machine via a network;

generating a second identifier associated with a second user identity, the second user identity to be stored in the shill cookie on the client machine, the second identifier being generated responsive to the at least one of the plurality of triggering events with respect to the network-based transaction facility;

... and

detecting a potentially fraudulent activity by detecting a lack of correspondence between the first identifier and the second identifier.³

Each of Applicants' other independent claims, namely claims 31 and 33, share with claim 1 limitations similar to at least those shown above.

In contrast to Applicants' claims, *Trostle* merely discusses a system in which a username is sent to a server. The server, in turn, compares the username against a list of authorized users.

FIG. 5 is a flow chart illustration of the login process based upon NDS authentication employed in NetWare 4.1. In step 82, a username prompt is presented to the user. In response, the user enters a username, which is transmitted to the server and in step 84 the server compares the entered username against a list of authorized users. If the username is not valid, network access is denied in step 86 and the login process ends. However, if the entered username is on the list, the server returns an encrypted private key to the workstation in step 88. The encrypted private key can only be decrypted with the user's password. In step 90 the server checks if any login restrictions, such as time restrictions, station restrictions, and account lockout restrictions have been violated. These restrictions prevent logins from unauthorized workstations or logins during the wrong time of day. If there are violations, access is denied (step 86). However, if there are no

³ Emphasis added.

login restrictions, the user is prompted to enter a password in step 92 and the validity of password is determined in step 94.⁴

Thus, *Trostle* fails to anticipate at least Applicants' claimed elements of "generating a first identifier associated with a first user identity, the first identifier to be stored in a shill cookie on a client machine of the first user," "generating a second identifier associated with a second user identity, the second user identity to be stored in the shill cookie on the client machine," and "detecting a potentially fraudulent activity by detecting a lack of correspondence between the first identifier and the second identifier."

Since Applicants have shown that not all the claimed elements were known as required by the *Net MoneyIn* court, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §102(b) with regard to independent claims 1, 31, and 33. Further, since claims 5, 6, 35, and 36⁵ depend, either directly or indirectly from claims 1 or 33, they too are allowable for at least the same reasons as the independent claims from which they depend. Further these dependent claims each may contain additional patentable subject matter.

Rejection of the Claims under 35 U.S.C. §103(a)

On page 4, paragraph 4 of the *Office Action*, the Examiner rejected claims 7, 8, and 37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Trostle* in view of *Buchner et al. (Discovering Internet marketing intelligence through online analytical web usage mining, ACM SIGMOD Record archive, Vol. 27, Issue 4, (December 1998), Pages: 51-61, Buchner)*. On page 5, paragraph 5 of the *Office Action*, the Examiner rejected claims 9-19 and 38 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Trostle* in view of *Buchner* as applied to claims 8 and 37 above, and further in view of *Miller* (Michael Miller, *The Complete Idiot's Guide to Online Auctions*, copyright July 1999). On page 9, paragraph 6 of the *Office Action*, the Examiner rejected claims 20-30 and 39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Trostle* in view of *Buchner* and *Miller* as applied to claims 19 and 38 above, and in further view of U.S. Patent No. 5,557,742 to *Smaha et al. (Smaha)*. Applicants respectfully traverse the rejections.

⁴ *Trostle* at col. 5, lines 45-67.

⁵ Claims 2-4, 32, 34, and 40 are canceled.

REQUEST TO REOPEN PROSECUTION UNDER 37 C.F.R. 41.50(a)

Serial Number: 09/905,046

Filing Date: July 12, 2001

Title: METHOD AND APPARATUS TO DETECT SUSPICIOUS TRANSACTION WITHIN A NETWORK-BASED AUCTION FACILITY

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Dkt: 2043.258US1

Each of the claims rejected under 35 U.S.C. §103(a), namely claims 9, 11-14, 16-19, 20, 21, 24, 25, 27, 29, 30, and 37-39 depend from amended independent claims 1, 31, or 33 that Applicants have shown to be allowable.⁶ Therefore, these dependent claims are allowable for at least the same reasons as the independent claims from which they depend. Further these dependent claims each may contain additional patentable subject matter. Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103(a) with regard to these dependent claims.

⁶ Claims 10, 15, 22, 23, 26, and 28 are canceled.

CONCLUSION

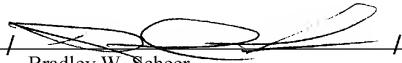
Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned attorney at 408/660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408/660-2015

Date 01 July 2010

By 
Bradley W. Scheer
Reg. No. 47,059

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of July, 2010.

Chris Bartl

Name

/ C. BARTL
Signature